

Application No.: 10/028,659

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Remarks

Claims 1-20 are pending. Claims 1-3 are amended.

Allowable Subject Matter

Applicants note with appreciation that Examiner found claims 16-18 allowable. Applicants defer adoption of Examiner's suggestion in view of the enclosed Amendment.

Objections

Claim 1 was objected to as "portion" was misspelled. Claim 1 has been amended to correct this typographical error. Claim 1 has also been amended to include a limitation from claim 2. Claims 2 and 3 have been amended to correspond to amended claim 1. Support for these amendments can be found in the claims as originally filed.

The Patent Office requested clarification for why claim 1 was listed as "Currently Amended" in Applicants' previous response. As originally filed, the first sentence of claim 1 read:

"1. 1. A method of applying a splicing tape to a roll . . ."

Applicants amended claim 1 to remove the redundant numeral 1.

In summary, Applicants respectfully submit that the objections to claim 1 have been overcome, and should be withdrawn.

§ 103 Rejections

Claims 1-6, 9-13, and 19-20 stand rejected under 35 USC § 103(a) as purportedly being unpatentable over Dylla et al., US 5,318,656 (Dylla et al. '656) in view of Dylla, US 5,330,125 (Dylla '125).

Claim 1 provides a method of applying a splicing tape to a roll of sheet material. The method comprises lifting a portion of an outer-most layer away from a remainder of the roll to form a lifted portion of the outer-most layer; applying the splicing tape to a wound portion of the roll; and applying pressure to the lifted portion of the outer-most layer to progressively place the lifted portion of the outer-most layer in contact with the remainder of the roll and the splicing

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tape. The lifting step includes lifting the portion of the outer-most layer away from the remainder of the roll with a sheet engagement mechanism.

Claim 9 provides an apparatus for applying a splicing tape to a roll of sheet material. The apparatus comprises a sheet engagement mechanism to lift an outer-most layer of the roll to form a lifted portion of the outer-most layer; a taping device to apply a slicing tape to the roll; and a paper applicator to apply pressure to the lifted portion of the outer-most layer to progressively place the lifted portion of the outer-most layer in contact with the remainder of the roll and the splicing tape.

The Patent Office, citing column 2, lines 21-24, asserts that Dylla et al. '656 shows lifting a portion of an outermost sheet from a remainder of the roll. (Paper No. 9, ¶ 2.) For the reasons discussed in their previous response, Applicants respectfully traverse this characterization of Dylla et al. '656. Specifically, with all embodiments, during use, an initial portion 41 is rolled off the roll 4 and placed on the base plate 6 (col. 6, lines 6-8). Dylla et al. '656 are entirely silent as to how the initial portion 41 is placed on the base plate 6. Notably, Dylla et al. '656 specifically do not describe, teach, or suggest that the initial portion 41 is "lifted" away from a remainder of the roll 4. Instead, Dylla et al. '656 only contemplates that the initial portion 41 is "rolled" off of the roll 4, meaning that the roll 4 itself is rotated, with a leading end of the initial portion 41 contacting the base plate 6 and moving forwardly along the base plate 6 with further rotation of the roll 4. In fact, relative to the embodiment of FIG. 9, Dylla et al. '656 specifically require a motor 21, shown as being mounted or connected to the central axis of the roll 4, for "rolling or spooling off the end portion 41." (col. 8, line 67 – col. 9, line 2; col. 12, lines 25-27).

Also, at column 2, lines 21-24, the passage cited by the Patent Office, Dylla et al. '656 specifically state that an initial portion of the web of a roll is rolled off and passed over a support table. (Emphasis added.) The Patent Office appears to acknowledge this difference between the present application and Dylla et al. '656, as it states "Dylla et al. '656 fails to show the end lifted against the force of gravity away from the remainder of the roll." (Paper No. 9, ¶ 2.)

To correct this deficiency in Dylla et al. '656, the Patent Office asserts that it would have been obvious to one of ordinary skill in the art at the time the invention was made to use the

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sheet engagement mechanism of Dylla '125 to tear and lift the outermost layer of web on the roll and bring it to the adhesive applying plate of Dylla et al. '656. (Paper No. 9, ¶ 2.)

Applicant respectfully traverses the proposed combination of references. In Dylla '125 the roll, when received, already has its end adhered to an underlying layer. Dylla '125 describes perforating a web while still in roll form, and, in a subsequent step, using a mechanism (e.g., a suction device) to lift and tear the web at the perforation. (See, col. 1, line 55- col. 2, line 26; and FIGS. 1-6.) Applicant respectfully submits that the Patent Office has failed to show how Dylla '125 describes, teaches or suggests using a suction device or any other mechanism to tear a leading edge that has not already been perforated.

Further, an object of the apparatus of Dylla et al. '656 is to prepare a paper web for use in a rotary printing machine so that is suitable for flying pasting or flying roll change. (See, col. 2, lines 9-14. See, also, col. 1, lines 15-22.) With the apparatus of Dylla et al. '656, an initial portion of the web from a new roll is rolled off and passed over a support table. A cutter and perforating tool is passed across the end region of the initial portion so that, in one operating step, and effectively simultaneously, the end is cut and, inwardly of the cut edge, a tear-off perforation is formed. (Col. 2, lines 21-28, emphasis added. See, also, col. 5, lines 22-55, and FIGS. 2 and 3 (describing and depicting the simultaneous cutting and perforating of the initial portion of the web).)

In addition, with the apparatus of Dylla et al. '265, a holding adhesive is applied on a surface segment of the web so that, upon winding the initial portion back on the roll, the segment having the holding adhesive applied is entirely covered by the region of the rewound portion which is between the cut edge and the perforating line. (See, col. 2, lines 35-41; and FIGS. 2 and 4a.) The result is shown in FIGS. 4a and 4b of Dylla et al. '265, which illustrate roll 4 with strip 44, extending from cut edge 42 to perforation 43, adhered to the underlying layer of roll 4 by adhesive strip 18 (of which migrated portion 18' is shown). (Col. 5, lines 56-68.)

Because one of the objects of the apparatus of Dylla et al. '656 is to simultaneous cut and perforate the leading edge of a roll, Applicant respectfully submits that one of ordinary skill in the art would not look to Dylla '125 for a lift mechanism that requires the roll to be perforated in order to tear and lift the outermost layer.

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The Patent Office asserts that the motivation to make the proposed combination is because Dylla '125 teaches that this system reduces scrap and requires fewer devices that systems including cutting and scrap removal. (Paper No. 9, ¶ 2.) Applicants respectfully submit that this purported advantage must be read in light of the full disclosure of Dylla '125. Specifically, Dylla '125 describes prior art systems that cut off a plurality of paper layers from a roll, creating high scrap. The removal of these layers required devices such a suction tubes and rollers for disposal. (See, col. 1, lines 29-50.)

In contrast to these devices, the apparatus of Dylla et al. '656 only cuts through one layer of paper. Thus, applicants respectfully submit that one of ordinary skill in the art would not be motivated to look to Dylla '125 for methods of reducing scrap, because Dylla et al. '656 already addresses and solves this problem.

For at least these reasons, the rejection of claims 1 and 9 under 35 USC § 103(a) as purportedly being unpatentable over Dylla et al. '656 in view of Dylla '125 is unwarranted and should be withdrawn.

Claims 2-6 and 19-20 each depend from claim 1 and add patentable features thereto. Claim 1 is patentable for at least the reasons discussed above, thus claims 2-6 and 19-20 are likewise patentable. Similarly, claims 10-13 each depend from claim 9 and add patentable features thereto. Claim 9 is patentable for at least the reasons stated above, thus claims 10-13 are likewise patentable.

In summary, the rejection of claim 1-6, 9-13, and 19-20 under 35 USC § 103(a) as purportedly being unpatentable over Dylla et al. '656 in view of Dylla '125 is unwarranted and should be withdrawn.

Claims 7 and 15 stand rejected under 35 USC § 103(a) as being unpatentable over Dylla et al. '656 in view of Dylla '125 as applied to claims 1 and 9 above and further in view of Wienberg et al. (5,916,651).

Claims 7 and 15 depend from claims 1 and 9, respectively. Claims 1 and 9 are patentable over Dylla et al. '656 in view of Dylla '125, for at least the reasons stated above. The Patent Office uses Wienberg for its purported teaching of a splicing tape having a first section and a second section wherein the outermost layer covers the first section of the splicing tape and the

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second section remains exposed adjacent the outermost layer. (Paper No. 9, ¶ 3.) Assuming, *arguendo*, that this characterization of Weinberg is accurate and there is proper motivation to combine the references, Applicants respectfully submit that the combination fails to correct the deficiencies of Dylla et al. '656 and Dylla '125, as described above.

For at least these reasons, the rejection of claims 7 and 15 under 35 USC § 103(a) as purportedly being unpatentable over Dylla et al. in view of Dylla as applied to claims 1 and 9 above and further in view of Wienberg et al. is unwarranted and should be withdrawn.

Claims 8 and 14 stand rejected under 35 USC § 103(a) as being unpatentable over Dylla et al. '656 in view of Dylla '125 as applied to claims 1 and 9 above and further in view of McCormick et al. (5,524,844).

Claims 8 and 14 depend from claims 1 and 9, respectively. Claims 1 and 9 are patentable over Dylla et al. '656 in view of Dylla '125, for at least the reasons stated above. The Patent Office uses McCormick for its purported teaching of a hold down roller. (Paper No. 9, ¶ 4.) Assuming, *arguendo*, that this characterization of McCormick is accurate and there is proper motivation to combine the references, Applicants respectfully submit that the combination fails to correct the deficiencies of Dylla et al. '656 and Dylla '125, as described above.

For at least these reasons, the rejection of claims 8 and 14 under 35 USC § 103(a) as purportedly being unpatentable over Dylla et al. in view of Dylla as applied to claims 1 and 9 above and further in view of McCormick et al. is unwarranted and should be withdrawn.

In view of the above, it is submitted that the application is in condition for allowance. Reconsideration of the application is requested.

Allowance all pending claims, as amended, at an early date is solicited.

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Date

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Respectfully submitted,

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